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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/995,213	11/26/2001	David L. Noone	ITT-229-D	1357

7590 06/23/2004

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EXAMINER

HOOK, JAMES F

ART UNIT PAPER NUMBER

3752

DATE MAILED: 06/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/995,213

Applicant(s)

NOONE ET AL.

Examiner

James F. Hook

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 35 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,524,673. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter of claim 35 is encompassed within the limitations of claim 1 of the '673 patent.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 35-45 are rejected under 35 U.S.C. 102(e) as being anticipated by Mitchell. The patent to Mitchell discloses the recited multilayer tubing comprising a first layer of an extrudable melt processible thermoplastic material, and at least one additional layer also made of an extrudable melt processible thermoplastic material which can also contain substituted and unsubstituted alkenes and vinyl alcohols or vinyl acetates, of which an ethylene content of 27%-35% can be used with vinyl alcohols, and where a third layer can also be provided which can be made of a plastic chemically dissimilar to at least the first layer, of which polyamides can be used as at least one of the thermoplastic materials, where the use of polyesters such as polybutylene and polyethylene terephthalates are used in an additional layer.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 35-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maillard in view of Mitchell. The patent to Maillard discloses the recited multilayer tubing comprising a first layer 12 of an extrudable melt processible thermoplastic material, and at least one additional layer 16 also made of an extrudable melt processible thermoplastic material which can also contain polymers of vinyl alcohols and vinyl acetates with ethylenes, and where a third layer can also be provided which can be made of a plastic chemically dissimilar to at least the first layer, of which polyamides can be used as at least one of the thermoplastic materials. The patent to Maillard discloses all of the recited structure with the exception of how much ethylene is used and using substituted or unsubstituted alkenes with vinyl alcohols or vinyl acetates and the equal use of polyesters such as polybutylene or polyethylene terephthalate. It would have been obvious to one skilled in the art to modify the thermoplastic material in Maillard, by providing the copolymers of vinyl acetate or vinyl alcohol with substituted or unsubstituted alkenes and by varying the amount of ethylene used to be 27-35% as which can be polyesters such as polybutylene or polyethylene terephthalate suggested by Mitchell as such would provide the benefits of the layers attaching more readily together, and Mitchell teaches the use of such as equivalent materials known for use in such environments.

Response to Arguments

Applicant's arguments filed July 3, 2003 have been fully considered but they are not persuasive. With respect to the arguments directed toward the date of Mitchell such

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is not persuasive because the applicant's addition of substituted and unsubstituted alkenes and acetates into the claim language precipitated the use of Mitchell in the office action, and such a limitation appears to have been added by CIP to the application 08/234,298 from which this application is related which has a filing date of April 28, 2004. The examiner could find no reference to this subject matter in the parent applications prior to this date, and since the material was apparently introduced into the specification of 08/234,298 by CIP, it is held that the earliest date applicant can be afforded for this subject matter is April 28, 2004. The patent to Mitchell in question was filed on February 7, 1994 which is prior to the effective date afforded applicant on this subject matter. Therefore, the reference to Mitchell predates applicants filing of an application which supports the claim language currently presented in the instant application. Predominantly most of applicants arguments are directed toward Mitchell not being applicable prior art, but as set forth above such is considered applicable prior art so all reference to such is moot, unless applicant can supply evidence to the contrary. With respect to full paragraph 4 on page 6 of applicants remarks, it is noted that only patent to Mitchell is being used in the previous and this office action, the reference to a rejection under Noone is not applicable when such was not used in the previous rejection to which these remarks are directed. Many of the remaining arguments are directed toward shortcomings of Maillard, however, such is not persuasive when most of the arguments are directed toward features of Maillard which are being modified by Mitchell, therefore it is considered that with no argument as to the improper combination of references, other than the matter of effective filing dates, that

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the combination of the references was not at issue, and any arguments directed toward Maillard not teaching claimed subject matter which is in fact being modified by the use of Mitchell is not persuasive when the examiner has set forth what Maillard lacked already and Mitchell teaches is known in the art. Therefore, Maillard as modified discloses all of the recited structure as set forth in the rejection above. Further, with respect to Mitchell, there is no argument as to what Mitchell teaches and therefore it is considered that there is no contention with what Mitchell teaches and that it meets the current claim language when no argument other than effective filing dates was provided against this reference. With respect to Maillard teaching various combinations, such is not persuasive when Maillard teaches the use of the materials recited, but as further modified teaches the specific materials based upon the teachings of Mitchell, therefore the reference to Mitchell provides further support and evidence that the specific materials claimed by applicant is known in the art.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

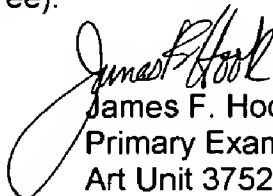
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James F. Hook whose telephone number is (703) 308-2913. The examiner can normally be reached on Monday to Wednesday, work at home Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Mar can be reached on (703) 308-2087. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


James F. Hook
Primary Examiner
Art Unit 3752

JFH